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| 09/810,258 | 03/19/2001 | Travis J. Parry | 10004013-1 | 8434 |

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| EXAMINER |
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SINGH, SATWANT K

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| ART UNIT | PAPER NUMBER |
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2626

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/810,258 | Applicant(s) PARRY, TRAVIS J. | |
| | Examiner Satwant K. Singh | Art Unit 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The following office action is in response to the amendment filed on 20 September 2004. Claims 1-24 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 14 is objected to because of the following informalities: "form a the modified document" should read as "form the modified" document. Appropriate correction is required.
4. Claim 23 is objected to because of the following informalities: "defined ,at least " should read as "defined, at least". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 9-17, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Hull et al. (US 2005/0024682).

7. Regarding Claim 1, Hull et al disclose a printing method, comprising the steps of:

a) receiving print stream data at a printer (document having document content 105) is sent from a document source 102 to a printer 106) (page 3, paragraph [0050]);

b) detecting a barcode in the received print stream data (pointer 236 to local storage takes the form of a barcode) (page 4, paragraph [0058]);

c) translating the barcode to an external network address (pointer to a multimedia content.....URL is an example of a multimedia pointer) (page 4, paragraph [0057]);

d) sending on the Internet or other external network an access request for a document to the external network address (pointer links to a video clip on the World Wide Web) (page 4, paragraph [0057]);

e) retrieving the document from the external network address (printer 204 detects and/or extracts the URL and retrieves the video clip pointed to by the URL) (page 4, paragraph [0057];

f) selecting at least one portion of the document retrieved from the external network address (printer 204 extracts key frames 234 from the video referenced by the pointer) (page 4, paragraph [0057]);

g) merging the at least one selection portion of the retrieved document from the network address into a second document, at least part of which is defined by the print stream data to form a modified document (Fig. 2, Document 206) (printed

document also prints the text 230 that was originally part of document 202 and the URL itself 232) (page 4, paragraph [0057]); and

h) printing the document (Fig. 2, Document 206) (page 4, paragraph [0057]).

8. Regarding Claim 2, Hull et al disclose a method, wherein the network address is a URL (pointer to a multi-media content.....URL is an example of a multimedia pointer) (page 4, paragraph [0057]).

9. Regarding Claim 3, Hull et al disclose a method, wherein said print stream data receiving step comprises receiving an e-mail containing said print stream data (person may receive an email containing information and/or a multimedia attachment) (page 1, paragraph [0021]).

10. Regarding Claim 4, Hull et al disclose a method Hull et al disclose a method, wherein said print stream data receiving step comprises receiving an e-mail with an attachment containing said print stream data (person may receive an email containing information and/or a multimedia attachment) (page 1, paragraph [0021]).

11. Regarding Claim 9, Hull et al disclose a method, wherein the translated barcode includes information on inserting the at least one portion of the retrieved document inside the second document (printer 204 extracts key frames ...referenced by the pointer and prints them in document 206); and further comprising the step of inserting the at least one portion of the retrieved document inside the second document in accordance with the printing information upon receipt of the document at the printer ((Fig. 5(a), Step 509) (printer decides and performs an action in accordance with the content of the received document) (page 6, paragraph [0097]).

12. Regarding Claim 10, Hull et al disclose a method, further comprising the step of inserting the at least one portion of the retrieved document inside a master document (Fig. 2, Document 206) (printed document also prints the text 230 that was originally part of document 202 and the URL itself 232) (page 4, paragraph [0057]).

13. Regarding Claim 11, Hull et al disclose a method, wherein the translation step comprises translating the barcode (pointer 236 takes the form of a barcode) to obtain at least one identifier that designates the type of contents in said retrieved document (pointer might be part of a text document or part of a more complex documentURL is a multimedia pointer) (page 4, paragraph [0057]; and determining a location for insertion of the at least one portion of the retrieved document within the master document based on said identifier (Fig. 2, Document 206) (printed document also prints the text 230 that was originally part of document 202 and the URL itself 232) (page 4, paragraph [0057]).

14. Regarding Claim 12, Hull et al disclose a method, wherein the translation step comprises translating the barcode to obtain coordinates designating a portion of the master document; and determining a location for insertion of the at least one portion of the retrieved document within the master document based on said coordinates (appearance and characteristics of a document to be printed) (page 5, paragraph [0076]).

15. Regarding Claim 13, Hull et al disclose a method, further comprising the step of determining a location of the at least one portion of the retrieved document within the master document based on a rule (appearance and characteristics of a document to be printed) (page 5, paragraph [0076]).

16. Regarding Claim 14, Hull et al disclose a method, wherein the at least one portion of the retrieved document and the master document are merged to form the modified document in a desired format (Fig. 2, Document 206).
17. Claims 15, 16, 21 and 22 are rejected for the same reason as claim 1.
18. Claim 17 is rejected for the same reason as claim 3.
19. Claim 19 is rejected for the same reason as claim 9.
20. Claim 20 is rejected for the same reason as claim 14.
21. Regarding Claim 23, Hull et al disclose a method, wherein the master document is defined, at least in part, by the print stream data (printer pre-caches web pages corresponding to URLs in the document under the assumption that those web pages will soon be accessed by the user printing the document with their URLs) (page 7, paragraph [0118]).
22. Regarding Claim 24, Hull et al disclose a method, wherein the master document comprises, at least in part, the second document (printer 304 detects web URLs in the PDL, retrieves those pages, and prints them as an attachment to the original document) (page 7, paragraph [0117]).

Claim Rejections - 35 USC § 103

23. Claims 5-8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. in view of Marx (US 6,348,970).
24. Regarding Claim 5, Hull et al fail to teach a printing method, wherein said translating step comprised translating the barcode to obtain a PIN#; and wherein said

sending step includes sending the PIN# with the access request to the external network address for determining if the request is authorized.

Marx teaches a printing method, wherein said translating step comprised translating the barcode to obtain a PIN# (password) (Table 2); and wherein said sending step includes sending the PIN# with the access request to the external network address for determining if the request is authorized (prompt user for a password at the beginning of each session) (Table 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Hull with the teaching of Marx to prevent unauthorized access to the URL address.

25. Regarding Claim 6, Hull et al fail to teach a method, wherein the detecting a barcode comprised interpreting a wrapper indicating that a binary sequence is a barcode.

Marx teaches a method, wherein the detecting a barcode comprised interpreting a wrapper indicating that a binary sequence is a barcode (identifying information can contain unique codes and can take various printed form such as a barcode) (col. 6. lines 15-26).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Hull with the teaching of Marx identify unique codes as being a barcode.

26. Regarding Claim 7, Hull et al fail to teach a method, further comprising the steps of: displaying a menu of print formats for a user to select to print the modified document; and receiving a selection of one said print formats displayed to the user.

Marx teaches a method, further comprising the steps of: displaying a menu of print formats for a user to select to print the modified document; and receiving a selection of one said print formats displayed to the user (exemplary6 user configuration information) (Table 2).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Hull with the teaching of Marx to allow the user to select the print format of the modified document.

27. Regarding Claim 8, Hull et al fail to teach a method, further comprising the steps of: displaying a field for a transmission address; receiving a transmission address for another device in said field; and sending the retrieved document to said another device.

Marx teaches a method, further comprising the steps of: displaying a field for a transmission address (default fax number) (Table 2); receiving a transmission address for another device in said field; and sending the retrieved document to said another device (page forwarding) (Table 2).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Hull with the teaching of Marx to allow the user to forward the document to another device.

28. Claim 18 is rejected for the same reason as claim 5.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ikeda (US 5,938,727) discloses a communication system and method via digital codes.

Bresnan et al. (US 6,429,946) discloses a system and method for barcode recognition in an electronic printstream.

Barrus et al. (US 6,784,899) discloses systems and methods for providing rich multimedia messages to remote users using telephones and facsimile machines.

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

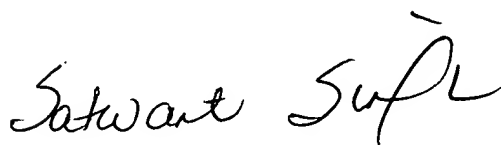
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



skS

Satwant K. Singh
Examiner
Art Unit 2626



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER